

Office Action Summary

Application No.

09/907,224

Applicant(s)

SAGIV ET AL.

Examiner

Peter Szekely

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the newly added paragraph on page 9, between lines 12 and 13, does not show that the polyester urethane, which is Dispercoll U54 according to applicants' specification, is a sulfonated polyester urethane. See U.S. Patent 6,180,244, column 14, lines 22-23. .

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-13 and 21-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The polyester urethane claimed is not the reaction product of the claimed monomers. It is the reaction product of the claimed monomers and sulfonic acid. Dispercoll U54 is a sulfonated polyester urethane. See paragraph #1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

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(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-6 and 9-11 rejected under 35 U.S.C. 102(e) as being anticipated by Rayner et al. 6,180,244.

6. Rayner et al. disclose Dispercoll U54 and Neorez 9617 in Tables 3a and 3b. Solvents are listed in column 7, lines 17-34. Surfactants can be found in column 6, lines 29-38. Applicants' claims are not novel.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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9. Claims 1-225 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rayner et al. 6,180,244, in view of Piret et al. 5,877,240

Rayner et al., besides the disclosures of paragraph #8, teach the use of silanes in column 6, lines 1-3. Although gamma-glycidoxypropyltrimethoxy silane is not mentioned, Piret et al. recite the use of said silane with polyester urethanes in claim 8. For concentrations see Example 1. For method of adhering, see Rayner et al., column 9, lines 10-45. Although the temperature and pressure conditions are different from the limitations claimed by applicants, there is no importance attached to these conditions in the specification, since the invention lies in the composition, and one of ordinary skill in the art can optimize the processing conditions without undue experimentation. The substitution of the silane of Piret et al., into the composition of Rayner et al is obvious, since it is a preferred silane to use with polyester urethanes according to Piret et al.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is 703-308-2460. The examiner can normally be reached on Tuesday-Friday 7:00 a.m.-5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
October 8, 2002



A DOCPHOENIX

APPL PARTS

IMIS _____
Internal Misc. Paper

LET. _____
Misc. Incoming Letter

371P _____
PCT Papers in a 371 Application

A... _____
Amendment Including Elections

ABST _____
Abstract

ADS _____
Application Data Sheet

AF/D _____
Affidavit or Exhibit Received

APPENDIX _____
Appendix

ARTIFACT _____
Artifact

BIB _____
Bib Data Sheet

CLM _____
Claim

COMPUTER _____
Computer Program Listing

CRFL _____
All CRF Papers for Backfile

DIST _____
Terminal Disclaimer Filed

DRW _____
Drawings

FOR _____
Foreign Reference

FRPR _____
Foreign Priority Papers

IDS _____
IDS Including 1449

NPL _____
Non-Patent Literature

OATH _____
Oath or Declaration

PET. _____
Petition

RETMAIL _____
Mail Returned by USPS

SEQLIST _____
Sequence Listing

SPEC _____
Specification

SPEC NO _____
Specification Not in English

TRNA _____
Transmittal New Application

CTNF _____
Count Non-Final

CTRS _____
Count Restriction

EXIN _____
Examiner Interview

M903 _____
DO/EO Acceptance

M905 _____
DO/EO Missing Requirement

NFDR _____
Formal Drawing Required

NOA _____
Notice of Allowance

PETDEC _____
Petition Decision

OUTGOING

CTMS _____
Misc. Office Action

1449 _____
Signed 1449

892 _____
892

ABN _____
Abandonment

APDEC _____
Board of Appeals Decision

APEA _____
Examiner Answer

CTAV _____
Count Advisory Action

CTEQ _____
Count Ex parte Quayle

CTFR _____
Count Final Rejection

INCOMING

AP.B _____
Appeal Brief

C.AD _____
Change of Address

N/AP _____
Notice of Appeal

PA.. _____
Change in Power of Attorney

REM _____
Applicant Remarks in Amendment

XT/ _____
Extension of Time filed separate

BACKFILE DOCUMENT INDEX SHEET

Internal

SRNT _____
Examiner Search Notes

CLMPTO _____
PTO Prepared Complete Claim Set

ECBOX _____
Evidence Copy Box Identification

WCLM _____
Claim Worksheet

WFEE _____
Fee Worksheet

File Wrapper

FWCLM _____
File Wrapper Claim

IIFW _____
File Wrapper Issue Information

SFRW _____
File Wrapper Search Info